

**REMARKS**

Claims 2-7, 9-35 and 37 are pending. Claims 2-7, 22-35 and 37 are rejected and claims 9-21 are withdrawn from consideration.

No new matter has been added by way of the present amendment. For example, claims 22 and 26 have been amended to recite "when said two or more powder coatings are applied for coating." This amendment is supported by originally filed claims 22 and 26 as well as the present specification at page 1, lines 5-11 as well as the present Examples. Accordingly, no new matter has been added.

Applicants request that the Examiner enter the present amendments since, as explained below, the finality of the outstanding Office Action is improper. Regardless, the present submission does not raise any new issues, which would require additional search and/or consideration on the part of the Examiner. The issue of a single-layered film has been previously argued and claimed in connection with the present application. As such, clarification of this claim limitation does not raise any new issues, which would require additional search and/or consideration on the part of the Examiner.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better condition for appeal.

**IMPROPER FINALITY OF OUTSTANDING OFFICE ACTION**

Applicants strongly traverse the Finality of the outstanding Office Action. This Finality is improper and should therefore, pursuant to MPEP § 706.07(e), be withdrawn.

On March 29, 2002, Applicants filed a Request for Continued Examination (RCE) pursuant to 37 CFR § 1.114. Concurrent with this RCE, Applicants filed a reply under 37 CFR § 1.111. The purpose behind the filing of a RCE is to withdraw the finality of the application. The action immediately subsequent to the filing of a RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.

This is not the case.

MPEP § 706.07(b) allows for a final rejection to be made on a first action only where (A) the new application is a continuing application of an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application. Applicants submit that neither of conditions B(1) nor B(2) of MPEP § 706.07(b) have been satisfied.

First, the claims of the present application are not drawn to the same invention claimed in the earlier application. The claims have been specifically limited to single layered powder

coating films. This issue has never been expressly recited in the present claims. Thus, the claims are not drawn to the same invention as claimed in the earlier application. Thus, condition (B)(1) is not met.

Second, all of the claims of the present application (1) are could not have been properly finally rejected on the same grounds in the next Office Action if they had been entered in the earlier application. As stated above, the single layered issue was never present, thus, the Examiner's grounds of rejection necessarily have changed. Accordingly, condition (B)(2) has not been met.

In summary, the finality of the outstanding Office Action is improper and should be withdrawn. In the event that the Examiner chooses to not withdraw the finality of the Office Action, Applicant hereby requests an Interview to discuss this issue.

#### Issues Under 35 U.S.C. §103(a)

The Examiner has maintained the rejection of claims 2-7, 22-35 and 37 under 35 U.S.C. §103(a) as being obvious over Millar et al., USP 3,860,557 (hereinafter referred to as Millar '557). Applicants respectfully traverse this rejection.

#### The Present Invention and its Advantages

The present invention relates to a combination of two or more powder coatings usable in a powder coating method for forming a single layered coating film having a visually homogeneous hue.

The single layered coating film resulting from applying the combination of the powder coatings of the present invention results in a single layer having a homogeneous hue. The single layer having a homogeneous hue is achieved by the present invention by controlling the difference in the triboelectric charge of each powder within a given range. In particular, the difference in triboelectric charge of said two or more powder coatings is 5.0  $\mu\text{C/g}$  or less.

Other parameters, such as the difference in average particle size, true specific gravity, apparent density, softening point, dielectric constant, and electric resistance of each of said two or more powder coatings are kept within specific ranges. Due to the nature of the powder coatings of the present invention, a single layered film can be achieved having a homogeneous hue.

#### Distinctions Between the Present Invention and Millar '557

Millar '557 relates to an electrostatic method of applying a multi-layered coating and products produced thereby. The multi-layered coating of Millar '557 is formed by applying to a substrate a composition containing two or more powders, provided that the powders of non-conductive materials have dielectric constants that differ from each other by a factor of at least 0.1. After the composition of Millar '557 is applied to the substrate, stratified layers of different powders form due to the different dielectric constants (Millar '557 at column 3, lines 1-11 and 42-

45). This is in contrast to the presently claimed single layered coating.

The Examiner asserts that the recitation of "wherein said two or more powder coatings form a single layered coating film having a homogeneous hue" limitation has little probative value. Applicants strongly disagree with the Examiner in this regard.

Applicants draw the Examiner's attention to the claim language of claims 22 and 26. In particular, these claims recite "wherein said two or more powder coatings form a single layered coating film having a homogeneous hue when said two or more powder coatings are applied for coating." This is not the subject matter disclosed in the Millar '557 reference.

The entire disclosure of Millar '557 is directed to the formation of stratified layers. Millar '557 relates to a multi-layered coating comprising stratified layers of different powders which are formed due to different dielectric constants (see Millar '557 at column 3, lines 1-11 and 42-45). Thus, Millar '557 fails to disclose a single layered coating film having a homogeneous hue.

A review of Millar '557 reveals the disclosure of a powder composition that comprises:

- A) zinc powder,
- B) an epoxy polymer powder, and
- C) a non-conductive organic polymer powder (see claim 1 of Millar).

Each of these powders corresponds to a separate layer in a multi-layered coating formed by Millar '557. These separate layers are formed due to differences in the physical properties between each of the powders A, B and C. In contrast, in the present invention, each of A, B, and C would correspond to individual powder coatings to be combined in a single layer.

Millar does not disclose the use of individual powder coatings within the same layer as suggested by the Examiner. The relevant passage of Millar '557 can be found at column 4, lines 8-15, which reads:

Normally, the coating compositions of the present invention will utilize 2 or 3 different components, to produce a resulting 2 or 3 layer coating on the substrate. It will, of course, be realized that one component or one final layer in the coating may be itself a mixture of two or more specific materials - e.g., two or more thermoplastic polymers having quite similar dielectric constants and quite similar specific gravities. When 3, 4, 5 or even more distinct coating components are utilized to produce 3, 4, 5 or even more layers in the final coating, each of the components should differ from the other components by the differentials set forth above as to dielectric constant, or chargeability, and specific gravity.

This passage clearly indicates that each of the above powders A, B and C may contain two or more materials such as thermoplastic polymers. However, it does not mean that the same layer may contain two or more powder coatings since Millar '557 aims at a stratified product.

The Examiner asserts that the particle sizes of the instant

claims and of Millar et al. are same or very similar. The Examiner goes on and erroneously concludes that the mixture of at least two powder coatings having such small particle sizes would yield a single layered coating film having a homogeneous hue. This is an incorrect assertion.

As is clear from the comparison between Examples A-1 to A-2 with Comparative Examples a-1 to a-3, the same results in the hue would not be obtained even if the powder coatings to be combined had the same particle size. Moreover, it is described in the present invention that when the difference in the triboelectric charges is too high, the electric lines of forces are likely to be concentrated during coating at the edge portion of the substrate to be coated. Thus, those powders having high triboelectric charges are likely to be agglomerated at the edge portion, thereby making it difficult to obtain a coating film having visually homogeneous hue (see page 13, line 28, page 41, line 2 of the present specification). Such a problem can be eliminated by adjusting the difference in triboelectric charges of each powder coating within a given range. Therefore, whether or not a homogeneous hue is obtained in the present invention is not dependent on the particle size of the powder coating.

The Examiner appears to believe that Applicants must show that Millar '557 is unable to provide a single layer coating film having homogeneous hue. Such evidence is unnecessary since it is evident from the face of Millar '557 that a single layered

coating film is not obtained. It is clearly described in Millar that the resulting coating film in Example I is a multi-layered film comprising layers of clear polyethylene powder, black epoxy powder and zinc dust, the layers sequentially forming from the surface (see column 9, 2 lines from bottom to column 10, line 8 of Millar). Therefore, since it is clear that the coating film in Millar is not a single layered film. Accordingly, the submission of example data is not be necessary.

In summary, the present invention is directed to a single layered coating having a homogeneous hue. The single layered coating of the present invention is made up of two or more powder coatings. Millar '557 fails to suggest or disclose each element of the presently claimed invention. Thus, the Examiner has failed to establish a valid *prima facie* case of obviousness. Accordingly, the Examiner is requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions concerning this application, he is requested to contact the Craig A. McRobbie (#42,874) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional



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fees required under 37 C.F.R. § 1.16 or under § 1.17;  
particularly, extension of time fees.

Respectfully submitted,

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Version with Markings to Show Changes Made

22. (Twice Amended) A combination of two or more powder coatings, comprising two or more color powder coatings wherein the color of each powder coating is different, wherein a difference in triboelectric charge of said two or more powder coatings is 5.0  $\mu\text{C/g}$  or less; wherein particles of each powder coating are not agglomerated; and wherein said two or more powder coatings form a single layered coating film having a homogeneous hue when said two or more powder coatings are applied for coating.

26. (Twice Amended) A powder coating composition which comprises two or more color powder coatings wherein the color of each powder coating is different, a difference in triboelectric charge of said two or more powder coatings is 5.0  $\mu\text{C/g}$  or less; wherein particles of each powder coating are not agglomerated, and wherein said two or more powder coatings form a single layered coating film having a homogeneous hue when said two or more powder coatings are applied for coating.

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